

Appl. No.09/943,749
Amdt. Dated Feb. 02, 2004
Reply to Office Action of September 9, 2003

REMARKS

Claims Rejections - 35 USC §112 First Paragraph

In paragraph 4 of the Office Action, the Office rejected claims 1, 8, 17-22, 28, 29, and 35-38 as failing to comply with the enablement requirement of the first paragraph of 35 U.S.C. 112, with respect to the base claim language, "constructed such that upon exposure to a fabric dye, the fiber bundle is dyed to an essentially visually uniform color density." Applicant has herein amended claim 38 to remove this language, thereby curing the rejection of claim 38.

With respect to claim 1 as amended, Applicant respectfully asserts that amending the claim to include the limitation of the fiber bundle to an "intimate blend" of the two types of fibers, as explained in the specification and at the interview, necessarily characterizes the different fibers as being joined before or at the picker, into a very uniform mixture. (Ref "intimate blend" in the Dictionary of Fiber & Technology, copyright 1999, Kosa) The amended claim 1 further requires, as described in the specification, that the fibers be "aligned" and have "direct and intimate contact" with each other. This is the construction by which the fiber bundle is able to be dyed to a visually uniform color density in the manner described, notwithstanding the well-known problems of dyeing high tenacity fibers with any kind of visual uniformity that does not exhibit a "heather" or mottled appearance to some extent. The amendment of claim 1 and these remarks having addressed the rejection, Applicant requests it be withdrawn.

Claims Rejections - 35 USC §102(b)

In paragraph 5 of the Office Action, the Office rejected claims 1, 8, 17-19, and 35-38 under 35 U.S.C. 102(b) as being anticipated by U. S. Patent No. 5,033,262 issued to Montgomery.

Montgomery's '262 is acknowledged by the Office as an example of a corespun yarn. A rejection based on anticipation requires that a single reference teach every element of the claim (MPEP § 2131). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Or stated in another way, a "claim is anticipated only if each and every element as set forth in the claim is found, . . . described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of*

Appl. No.09/943,749

Amdt. Dated Feb. 02, 2004

Reply to Office Action of September 9, 2003

California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Montgomery as a corespun product is not and cannot include the limitations of amended independent claims 1 and 38 as requiring an "intimate blend" construction of fibers. A corespun design is the very antithesis of an intimate blend, as is well understood in the art. It cannot be characterized as having all fibers "aligned" and all fibers "oriented substantially normal to a cross section" of the fiber bundle. The Office at the interview last year agreed with the prior entered limitation of "oriented substantially normal to a cross section" as excluding corespun designs, and dropped its earlier rejections based on corespun disclosures. This Applicant respectfully asserts again and again that this invention as claimed is not remotely associated with, anticipated by, derived from, or comparable to any corespun design. Applicant urges reconsideration of claims 1 and 38 as amended and of the remaining dependent claims cited, as well as the withdrawal of Montgomery as a basis for this and all other rejections hereunder.

Claims Rejections - 35 USC §102(e)

In paragraph 9 of the Office Action, the Office rejected claims 1, 17-19, and 35-38 under 35 U.S.C. 102(b) as being anticipated by U. S. Patent No. 6,146,759 issued to Land. Land is another corespun yarn, as is admitted by the Office. Applicant invokes its prior comments above and in previous correspondence concerning Montgomery and corespun constructions and asserts them to be equally applicable to Land. Applicant urges reconsideration of the claims as amended and the claims dependent thereon, and withdrawal of Land as a basis for this and all other rejections hereunder.

Claim Rejections - 35 USC § 103

In paragraphs 10 and 11 of the Office Action, Office has rejected claims 22, 28, and 29 as being unpatentable respectively over the '262 reference, and the '759 reference. Applicant again invokes its prior comments about the inapplicability of Montgomery and Land as prior art and corespun technology in general as distinguished from the invention as presently claimed. Applicant notes further that in each of the three cases, the Office acknowledges that neither Montgomery nor Land teaches the elements of interest.

Appl. No.09/943,749

Amdt. Dated Feb. 02, 2004

Reply to Office Action of September 9, 2003

According to the MPEP §2143.01, as is amply supported in the case law, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art." In light of the base claims as amended, and the Applicant's comments with regard to the cited art and to corespun in general, Applicant cannot discern the required "teaching, suggestion, or motivation" that would lead one from there to the claimed invention without inventive effort. Applicant requests the rejected claims be reconsidered in light of the amended base claims and these remarks.

In paragraph 12 of the Office Action, Office has rejected claims 8 as being unpatentable over the '759 reference in view of U.S. Patent No. 6,562,741 issued to Lilani. Applicant again invokes its prior comments regarding 102 and 103 rejections, the '759 and other corespun references, and the amendments to the base claim upon which claim 8 depends. Section 2143.01 of the MPEP states: "The mere fact that references can be combined or modified is not sufficient to establish prima facie obviousness." In addition, the "level of skill in the art cannot be relied upon to provide the suggestion to combine references." There must be some objective reason to combine the teachings of the references to make the claimed invention.

Lilani discloses stock dyed material and is not helpful alone or in combination with Land or any corespun art to teach or suggest the invention as claimed. Further, claim 8 should be allowable at least on the basis of being dependent on an allowable base claim. Applicant requests reconsideration.

In paragraphs 13 and 14 of the Office Action, Office has rejected claims 20-21 as first being unpatentable over the Montgomery '262 reference in light of U.S. Patent No. 5,853,885 issued to Prickett, and also as being unpatentable over the Land '759 reference in view of the '885 reference or in the alternative, the '759 reference in view of US Patent No. 6,381,940 issued to Kolmes et al. in further view of the '885 reference. Applicant invokes its prior comments with regard to the amended base claims, Montgomery, Land, corespun art in general, and 35USC 102 and 103 rejections, and asserts that both Montgomery and Land should be withdrawn as a reference with respect to the invention as claimed; that there is no objective reason for making

Appl. No.09/943,749
Amdt. Dated Feb. 02, 2004
Reply to Office Action of September 9, 2003

the cited combination in the context of the amended base claims upon which claims 20 and 21 depend. Further, claims 20 and 21 should be allowable at least on the basis of depending on allowable base claims. Applicant respectfully requests reconsideration of claims 20 and 21 in light of the amendments to base claims and the related remarks.

Withdrawn Claims

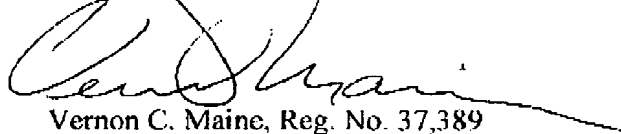
Claims 74-78, having been withdrawn earlier in the prosecution, are dependent on amended claim 1, and are likewise allowable if claim 1 is allowable, at least on that basis. Applicant requests they be reinstated and reconsidered.

New Claims

New claims 79 and 80 are dependent on amended claim 1, and include limitations well understood in the art to exclude the heavier corespun yarns and products thereof as were disclosed in the art cited by the Office in the prosecution, and so should be allowable for that reason.

Applicant believes the above amendments and remarks to be fully responsive to the Office Action, thereby placing this application in condition for allowance. No new matter is added. Applicant requests speedy reconsideration, and further requests that Examiner contact its attorney by telephone, facsimile, or email for quickest resolution, if there are any remaining issues.

Respectfully submitted,



Vernon C. Maine, Reg. No. 37,389
Scott J. Asmus, Reg. No. 42,269
Neil F. Maloney, Reg. No. 42,833
Andrew P. Cernota, Reg. No. 52,711
Attorneys/Agents for Applicant

Cus. No. 24222
Maine & Asmus
PO Box 3445
Nashua, NH 03061-3445
Tel. No. (603) 886-6100, Fax. No. (603) 886-4796
Info@maineandasmus.com